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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/570,015	09/28/2006	Yuji Ishino	P/5495-5	5306

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EXAMINER	
O'HERN, BRENT T	
ART UNIT	PAPER NUMBER
1783	
MAIL DATE	DELIVERY MODE
06/04/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/570,015	ISHINO ET AL.	
	Examiner	Art Unit	
	BRENT T. O'HERN	1783	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 March 2010*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3 and 5-9* is/are pending in the application.

4a) Of the above claim(s) *5-9* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claims

1. Claims 1-3 and 5-9 are pending with claims 5-9 withdrawn.

WITHDRAWN REJECTIONS

2. All rejections of record in the Office action mailed 12/30/2009 have been withdrawn due to Applicant's amendments in the Paper filed 3/26/2010.

NEW OBJECTIONS

Specification

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the phrases "an open-topped plastic box placed in said plastic packing bag, with a substantially continuous empty internal space extending between the plastic box and the plastic packing bag" in claim 2, lines 5-6 and "the continuous empty internal space in said plastic packing bag having a volume 0.2 to 0.6 times that of said sushi product at the time of thawing" in claim 2, lines12-13 are not supported by the text of the Specification. If Applicant believes support is present in figures then Applicant is advised to consider amending the text of the Specification to incorporate said language.

Claim Objections

4. Claim 1 is objected to because of the following informalities: the phrase "600mm" in line 4 is written without a space. Appropriate correction is required.

NEW REJECTIONS

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-3 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

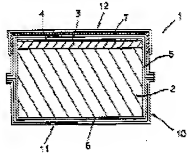
7. The phrase "the continuous empty internal space in said plastic packing bag having a volume 0.2 to 0.6 times that of said sushi product at the time of thawing" in claim 2, lines12-13 is new matter. The disclosure as filed does appear to have support for a bag having empty space and the bag having a volume 0.2 to 0.6 times that of said sushi product at the time of thawing, however, the claim is open by the "comprising" language and the space in the bag that is not the sushi is not limited to empty space but rather can be occupied by other materials. Thus, there is not support in the original disclosure for the "empty space" as being the only material other than sushi.

Claim Rejections - 35 USC § 103

8. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishino et al. (JP 2001275591) in view of Guarino (US 5,863,576) and Reutimann (US 5,540,944).

Ishino ('591) teaches a microwavable vacuum-packed frozen sushi product *(See Drawing 2 and paras. 1, 6 and 12-14, packaged sushi product #1, with rice #2, ingredient #3 and white-sheet kelp #4.)*

【図２】



with the packaging material made of a nylon and polyolefin films, comprising a vacuumed, frozen and hermetically sealed flexible microwave-safe plastic packing bag *(See paras. 13-14 and Drawings 1-2, sushi product #1, nylon #9 surrounded by hermetically sealed flexible plastic bag #10.);* a frozen sushi product which is formed by at least one shaped form of frozen cooked rice and a sushi material with a space around the sushi product *(See paras. 6, 13-14 and Drawing 2, sushi product #1 with rice #2. The rice is interpreted as being boiled as this is the known method of cooking rice for sushi.)*, the packaging bag, the box and the sushi product being frozen together in a unified form, and the shaped product capable of being so prepared and confined that upon exposure to microwave energy for a predetermined time, steam can emanate from

the rice so as to fill the space and to uniformly heat the sushi material by said steam after the predetermined time, to raise the temperature thereof without exceeding a maximum temperature for the sushi material, at which maximum temperature the taste of the sushi is impaired *(See paras. 13-14 and Drawing 2. The claims are interpreted as being directed to a product and not to a method of making or using the product.)* and an inner surface of the plastic packing bag being in contact with an upper surface of the sushi product *(See paras. 13-14 and Drawing 2. The claims do not state the contact as being direct or indirect contact.)*, however, fails to expressly disclose the vacuum in the bag being 600 mm Hg or lower, an open-topped plastic box wherein the box is a shallow cylinder, a tray or dish container having a rectangular (or square) or circular or oval shape in plan view that is placed in said plastic packing bag and frozen together with the bag and the sushi product with the bag made of both nylon and polypropylene with the polypropylene being thicker than the nylon and the plastic packaging bag with the continuous empty internal space in the plastic packing bag having a volume 0.2 to 0.6 times that of the sushi product at the time of thawing.

Guarino ('576) teaches a seafood product placed on a surface of a plastic rectangular box that is placed inside of a vacuum sealed plastic bag #16 made of nylon/ polypropylene *(See FIGs 1-2, col. 3, ll. 34-46 and col. 3, l. 65 to col. 4, l. 3, seafood product #12 on box #14 that is placed in plastic bag #16. Sushi is known to include seafood products.)*

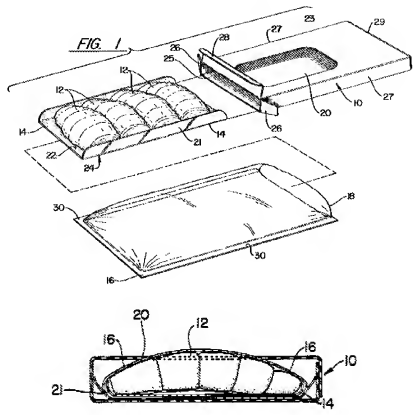


FIG. 2

for the purpose of providing an attractive, safe, fresh, frozen food product that can be microwaved *(See Abstract and col. 1, l. 40 to col. 2, l. 17.)*. The polypropylene enables the bag to tolerate temperature extremes and nylon contributes to strength *(See col. 3, l. 65 to col. 4, l. 3.)*.

Reutimann ('944) teaches vacuum packaging fish steaks or fillets at 600 mm Hg *(See col. 14, ll. 16-25.)* for the purpose of providing a microbiologically stable food that is capable of being stored for extended periods of time *(See col. 7, ll. 19-36 and col. 9, ll. 36-50.)*. It was known in the art that the stronger the vacuum that is pulled the less residual oxygen will be available that can degrade the food in the container. Thus, if the

food inside the bag is supercritical to even low levels of oxygen or the storage time is very long then it would have been obvious to pull a stronger vacuum.

Regarding the ratio of empty internal space, it would have been obvious that as the sushi cools the pressure will increase resulting in the bag expanding. Also when the sushi is heated in the microwave the air and moisture in the bag will expand creating empty internal space. When it comes to protecting the sushi from degradation it is not the amount of empty space that is important but rather the amount of oxygen. Furthermore, it would have been obvious to one having ordinary skill in the art to adjust the free space for the intended application since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Regarding the relative thickness of the film layers, it would have been obvious to one having ordinary skill in the art to adjust the thickness to the above layers for the intended application since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Therefore, it would have been obvious to place Ishino's ('591) sushi product on a box and insert it into a bag as taught by Guarino ('576) with a vacuum as taught by Reutimann ('944) in order to provide an attractive, safe food product that can be microwaved.

Double Patenting

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 1-3 of Application No. 10/570,015 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 2, 4 and 6 of copending Application No. 11/817,285. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious that the sushi product is capable of being heated by steam after thawing as the structure is the same as claimed.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

11. Claims 1-3 of Application No. 10/570,015 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 2 and 4-5 of copending Application No. 10/570,016.

Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious that steam would emanate from the rice as the structure is the same as claimed.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

ANSWERS TO APPLICANT'S ARGUMENTS

12. In response to Applicant's arguments *(See pp. 7-10 of Applicant's Paper filed 3/26/2010.)* that the prior art does not teach the new "empty space" and new "600 mm Hg" limitations, it is noted that said new limitations are discussed above.

13. In response to Applicant's arguments *(See p. 8, para. 2 to p. 9, para. 1 of Applicant's Paper filed 3/26/2010.)* that it would not have been obvious to use a box as taught by Guarino to package sushi because sushi is soft by its very nature as opposed to lobsters as taught by Guarino, it is noted that when sushi is frozen it is no longer soft but rather hard and depending on its shape and how it is packed, as sharp hard edges can be created that are capable of breaking the packaging material. Furthermore, sharp objects that are external to the package also have to be considered as these objects can also puncture the packaged materials in a similar manner as the internal items.

14. In response to Applicant's arguments *(See p. 9, paras. 2-3 of Applicant's Paper filed 3/26/2010.)* that the prior art does not teach the new "empty space" limitations, it is noted that said new limitations are discussed above.

15. In response to Applicant's arguments *(See p. 10, para. 2 of Applicant's Paper filed 3/26/2010.)* that the prior art does not teach the new "600 mm Hg" limitations, it is noted that said new limitations are discussed above.

16. In response to Applicant's comments *(See p. 10, paras. 3-5 of Applicant's Paper filed 3/26/2010.)* regarding the double patenting rejections and the claims not being patented yet, it is noted that said comments have been considered and the rejections are discussed above.

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRENT T. O'HERN whose telephone number is

(571)272-6385. The examiner can normally be reached on Monday-Thursday, 9:00-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Sample can be reached on (571) 272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Brent T O'Hern/
Examiner, Art Unit 1783
May 23, 2010

/David R. Sample/
Supervisory Patent Examiner, Art Unit 1783